

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN SAMONIDES

Appeal No. 96-3586
Application 08/262,848¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, COHEN,
Administrative Patent Judge, and MEISTER, Administrative
Patent Judge.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed June 21, 1994. According to appellant, this application is a division of Application 07/971,351, filed November 4, 1992, now U.S. Patent No. 5,346,738.

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John Samonides (the appellant) appeals from the final rejection of claims 14 and 15, the only claims remaining in the application.

We AFFIRM.

The appellant's invention pertains to a method of permanently marking an identifying indicia on a part. Independent claim 14 is further illustrative of the appealed subject matter and a copy thereof may be found in Appendix A of the brief.

The references relied on by the examiner are:

Altman	3,963,338	Jun. 15, 1976
Wright et al. (Wright)	4,687,725	Aug. 18, 1987
Lawson	5,044,791	Sep. 3, 1991

Claims 14 and 15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Altman, Lawson or Wright.

The rejections are explained on pages 2-4 of the final rejection. The arguments of the appellant and examiner in

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support of their respective positions may be found on pages 3-9 of the brief and pages 6-10 of the answer.

OPINION

Considering first the rejection of claims 14 and 15 under 35 U.S.C. § 112, second paragraph, the examiner is of the opinion that the recitation of a part "such as" an automobile part in independent claim 14 renders the claims indefinite. As to claim 15, the examiner is further of the opinion that the recitation of the release of the encapsulated surface etchant being accomplished over a "predetermined period of time" is also indefinite.

With respect to the "such as" limitation in independent claim 14, the appellant argues:

That statement to which the examiner objects is merely exemplary as [to] the type of part which may be permanently marked by the method. It certainly does not render the claim unclear. If anything, it renders it more clear. It is perfectly clear that the method permanently marks indicia on a part such as, for example, an automobile part. How could the statement be more clear? [Brief, page 3.]

The appellant's arguments are not persuasive. The recitation "such as an automobile part" is vague and uncertain since it is not clear from the specification what the

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appellant intended to cover by the recitation "such as." Note ***Ex parte Remark***, 15 USPQ2d 1498, 1500 (Bd. Pat. App. & Int. 1990); ***Ex parte Kristensen***, 10 USPQ2d 1701, 1703 (Bd. Pat. App. & Int. 1989); ***Ex parte Steigerwald***, 131 USPQ 74, 75 (Bd. App. 1961); ***Ex parte Hasche***, 86 USPQ 481, 482 (Bd. App. 1949); and ***Ex parte Hall***, 83 USPQ 38, 39 (Bd. App. 1948). The appellant's specification provides no restricting examples or guidelines for use in determining when a particular part is, or is not, to be considered a part "such as" an automobile part and, accordingly, one of ordinary skill in the art is precluded from determining the metes and bounds of the claimed subject matter. Indeed, this uncertainty is exemplified by the fact that the appellant with respect to the § 103 rejection (1) appears to contend that there is a "great deal of difference" between the marking of a part "such as" an automobile part and the marking of the "part" (i.e., the metal coated sheet) of Altman (see the paragraph bridging pages 5 and 6 of the brief) and (2) that in Lawson the wire, rather than the outer layer or covering of the sleeve label 22, must be considered to be the part "such as" an automobile part (brief, page 6) whereas the examiner urges that both the

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graphic product of Altman and the sleeve label of Lawson can be considered to correspond to such a part.

We cannot, however, agree with the examiner that the recitation in dependent claim 15 of the release of the encapsulated surface etchant being accomplished "over a predetermined period of time" by the dissolution of all or part of the encapsulating constituent renders this claim indefinite. One of ordinary skill in this art would understand, dependent upon the particular thickness and type of material selected for the encapsulation of the etchant, that the encapsulating material will dissolve and release the etchant in a finite period of time which can be "predetermined."

Since claim 15 is indefinite by virtue of its dependency on claim 14, we will sustain the rejection of claims 14 and 15 under 35 U.S.C. § 112, second paragraph.

Turning to the rejection of claims 14 and 15 under 35 U.S.C. § 103 as being unpatentable over either Altman, Lawson or Wright, we note that normally a claim which fails to comply with the second paragraph of § 112 will not be analyzed as to whether it is patentable over the prior art since to do so

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would necessarily require speculation with regard to the metes and bounds of the claimed subject matter. **See *In re Steele***, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and ***In re Wilson***, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Nevertheless, in this instance, in an effort to avoid piecemeal appellate review (**see *Ex parte Saceman***, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993) and ***Ex parte Ionescu***, 222 USPQ 537, 540 (Bd. App. 1984)) we make the following interpretations of the terminology appearing in independent claim 14 for the purpose of reaching the rejection based on prior art. In claim 14, lines 1 and 2, we interpret "a part such as an automobile part" to be -- a part --.

Turning specifically to the rejection of claim 14 under 35 U.S.C. § 103 based on the teachings of Altman, the appellant argues that:

The etchant [of Altman] etches through an extremely thin vapor-deposited aluminum or zinc coating to produce a specularly reflective mark for projection. Altman's "alternate embodiment" (Col. 5, line 67 **et seq.**) suggests coating the entire surface of the sheet with "microcapsules which contain an etchant fluid["] and using the marking pen 96 merely to rupture the capsules. There is nothing in this patent which would show a person skilled in the art how to permanently mark an identifying indicia on a part such as an automobile part using a marking

mixture of ink and an encapsulated surface etchant. There [is] a great deal of difference between the marking of a part and the use of an ink containing a base or acid for marking a paper sheet having a metallized coating, the thickness of which is in the range of 500-2500 Angstrom units, see column 4, lines 35-36. The ink in the marker of the alternative embodiment does not contain an encapsulated etchant. Indeed, an encapsulated product probably would not flow through a porous marking pen applicator. [Brief, pages 5 and 6.]

We do not find these contentions persuasive. The appellant's argument that the "ink in the marker of the alternative embodiment does not contain an encapsulated etchant" is not commensurate with the scope of the claimed subject matter. That is, independent claim 14 more broadly sets forth the step of applying an indicia printed "with a mixture of a visible ink and an encapsulated surface etchant," rather than microcapsules of etchant contained within the ink as the appellant appears to argue. In the embodiment of Fig. 7, Altman discloses a graphic product or "part" that includes a layer 88 of vapor deposited aluminum and a layer 94 of microcapsules which is adhered to the layer of aluminum by an adhesive 92. With respect to an **alternative embodiment** of Fig. 7 it is stated that:

In an alternative embodiment of the product of **FIG. 7**, granules **94** are in the form of microcapsules

which contain an etchant fluid of the type disclosed in connection with **FIG. 6** and marker **96** is simply a pressure applying element capable of rupturing the capsules in order to release the etchant fluid.
[Col. 5, line 67, through col. 6, line 4.]

Considering the embodiment of Fig. 6, in order to determine the type of etchant fluid used, Altman in col. 5, lines 29 and 30, refers to "the dyes in etchant fluid **86, 112**" and in col. 5, lines 3-21, makes it clear that the fluid 86 (i.e., "ink" - see col. 5, line 3) of this embodiment contains **both** a dye and an etchant. Thus, in the alternative embodiment of Fig. 7, both the "ink" and etchant are contained in the microcapsules. Accordingly, giving the terminology of independent claim 14 its broadest reasonable interpretation,² a "mixture of a visible ink and an encapsulated surface etchant" can be considered to be applied to the etchable surface 88 when the microcapsules are ruptured by the pressure applying element in the alternative embodiment of Fig. 7. It is also clear that

² The terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)).

the pressure applying element in the alternative embodiment of Fig. 7 is simply a pressure applying instrument rather than a "porous marking pen applicator" as the appellant would have us believe. As to the appellant's reference to a particular thickness of the metallized coating on the graphic product or "part" of Altman, independent claim 14 does not require that the etchable surface be of any particular thickness.³

In view of the foregoing, we will sustain the rejection of claim 14 under 35 U.S.C. § 103 as being unpatentable over Altman.

Turning to the rejection of claim 14 under 35 U.S.C. § 103 based on the teachings of Lawson, the appellant concedes that the Lawson patent places a visible mark on the outer layer or covering of the "sleeve label" 22 by etching but, nevertheless, contends that "[t]here is no indication that the part itself, i.e., the wire, is to be etched" (brief, page 6). We must point out, however, that notwithstanding the fact that the outer layer or covering (col. 3, lines 8 and 9) of sleeve label 22 is subsequently placed over a wire, this

³ It is well settled that features not claimed may not be relied upon in support of patentability. *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

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sleeve and its outer layer or covering can, giving the terminology of independent claim 14 its broadest reasonable interpretation (*In re Morris, supra*, and *In re Zletz, supra*) broadly be considered to be a "part."

The appellant also contends that there is no indication in Lawson of "any mixture of ink with an etchant much less with ink and an encapsulated etchant" (brief, page 6). We do not agree.

Lawson states that

the pressure sensitive material is of the type having micro-encapsulated material which ruptures when impressed by a print character. The micro-encapsulated material is preferably an etchant which burns into a layer covering the etchant, thereby burning a dark color into the covering from beneath. **Other micro-encapsulated material**, such as a colorant material, or two different materials which produce a color when mixed together by rupturing, may be used. [Col. 3, lines 4-12; emphasis added.]

In our view, the reference by Lawson to the "other encapsulated material" as being a "colorant material," if not teaching, would at least fairly suggest⁴ to the artisan that

⁴ The issue of obviousness is not only determined by what the references expressly state but also is determined by what they would fairly suggest to those of ordinary skill in the art. *See, e.g., In re DeLisle*, 406 F.2d 1386, 1389, 160 USPQ 806, 808-09 (CCPA 1969) and *In re Bozek*, 416 F.2d 1385, 1390,

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the colorant material be "ink."⁵ When the microcapsules of etchant material and colorant material or ink are ruptured, a "mixture of a visible ink and an encapsulated surface etchant" can be considered to be applied to the layer or covering. This being the case, we will sustain the rejection of claim 14 under 35 U.S.C. § 103 as being unpatentable over Lawson.

Considering next the rejection of claims 14 and 15 under 35 U.S.C. § 103 based on the teachings of Wright, the examiner notes that Wright discloses (1) "a method of etching in which encapsulated etchant is used (e.g. at col. 2, lines 35-43)" (answer, page 8) and (2) that "the microcapsules can be applied to the substrate neat or mixed with adhesive, col. 8-9" (answer, page 5). While this may be true, Wright's method

163 USPQ 545, 549-50 (CCPA 1969). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. **See In re Preda**, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

⁵ **Webster's Third New International Dictionary of the English Language, Unabridged**, G. & C. Merriam Co., Springfield, MA, 1961, defines "ink" as -- 1a: a fluid or viscous material of various colors . . . that is composed essentially of a pigment or dye in a suitable vehicle and is used for writing and printing . . . b: a similar solid preparation . . . --.

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is directed to forming relief images such as intaglio printing plates (col. 1, lines 7-9). To this end, Wright adheres a layer of microcapsules (that includes a photosensitive composition and an etchant) on an etchable support "such as a support useful in preparing a printing plate, a printed circuit, or the like" (col. 2, lines 2 and 3). The photosensitive composition hardens when exposed to actinic radiation and areas of the etchable support which are not desired to be etched are exposed to such radiation in order that the capsules will resist rupture during the application of a force to the layer of microcapsules. Accordingly, when a force is subsequently applied to the entire microcapsule layer, the microcapsules will be ruptured only in those areas that have not been exposed to actinic radiation, resulting in a relief pattern being formed on the etchable support (see, generally, column 2). Thus, while Wright broadly teaches an etchant contained in rupturable microcapsules, there is absolutely nothing therein which would either teach or fairly suggest "applying to the etchable surface an indicia printed with a **mixture of a visible ink** and an encapsulated surface etchant" (emphasis added) as set forth in independent claim

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14. With respect to claim 15, we further find nothing in Wright which would either teach or fairly suggest "a time release encapsulation" as claimed. Accordingly, we will not sustain the rejection of claims 14 and 15 under 35 U.S.C. § 103 as being unpatentable over Wright.

Considering last the rejection of claim 15 under 35 U.S.C.

§ 103 based on the teachings of either Altman or Lawson, it is the examiner's position that:

Various encapsulating materials were known in the art at the time of the invention, including materials usable for time release encapsulation. It would have been within the general skill of a worker in the art at the time of the invention to select an appropriate encapsulating material based on the intended use/application/mode of action of the etching mixture. [Answer, page 5.]

We will not support the examiner's position. As the examiner apparently recognizes, there is nothing in either Altman or Lawson which either teaches or fairly suggests time release encapsulation. Obviousness under § 103 is a legal conclusion based on **factual evidence** (*In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)) and the mere fact that, as a broad proposition, time release encapsulating materials were known, does not provide a sufficient factual

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basis for establishing the obviousness of the claimed time release encapsulation within the meaning of 35 U.S.C. § 103 (**see *In re GPAC Inc***, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995) and ***In re Warner***, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), ***cert. denied***, 389 U.S. 1057 (1968)). Therefore, we will not sustain the rejection of claim 15 under 35 U.S.C. § 103 as being unpatentable over either Altman or Lawson.

In summary:

The rejection of claims 14 and 15 under 35 U.S.C. § 112, second paragraph, is affirmed.

The rejection of claim 14 under 35 U.S.C. § 103 (1) based on the teachings of either Altman or Lawson is affirmed and (2) based on the teachings of Wright is reversed.

The rejection of claim 15 under 35 U.S.C. § 103 based on the teachings of either Altman, Lawson or Wright is reversed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

	Harrison E. McCandlish, Senior)	
	Administrative Patent Judge)	
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	Irwin Charles Cohen)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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